

Application No.: 09/707,269

Case No.: 53415US038

**REMARKS**

Upon entry of the present amendment, claims 16, 19-26, 29-38, and 41-43 will be pending. Claims 27, 28, 39, and 40 have been canceled. Independent claims 16, 36, and 41 have been amended to specify that the passivating agent comprise a material selected from the group consisting of benzotriazole, azole derivatives of benzotriazole, and tolytriazole.

As a preliminary matter, Applicant maintains that the 35 U.S.C. § 102(e) rejection in view of U.S. Pat. No. 6,546,939 (Small '939) is not proper. However, in an effort to further prosecution, Applicant has amended the independent claims to further clarify that the claimed invention is not anticipated or obvious in view of Small '939. Reconsideration of the application in view of the following remarks is requested.

**I. Claims 16, 19-26, 31, 36-38, and 41-43 are Novel in view of Small '939**

Claims 16, 19-26, 31, 36-38, and 41-43 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Pat. No. 6,546,939 (Small '939). Applicants request reconsideration of this rejection because Small '939 does not teach or suggest the use of benzotriazole, azole derivatives of benzotriazole, or tolytriazole as a passivating agent in a working liquid. For at least this reason, the rejection of claims 16, 19-26, 31, 36-38, and 41-43 under 35 U.S.C. § 102(e) as allegedly being anticipated by Small '939 should be withdrawn.

**II. Claims 29, 30, and 32-35 are Not Obvious in view of Small '939**

Claims 29, 30, and 32-35 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of Small '939. Applicants request reconsideration of this rejection because, as discussed above, Small '939 fails to teach or suggest the use of benzotriazole, azole derivatives of benzotriazole, or tolytriazole as a passivating agent in a working liquid. For at least this reason, the rejection of claims 29, 30, and 32-35 under 35 U.S.C. § 103(a) as allegedly being obvious in view of Small '939 should be withdrawn.